

Remarks

In the Office Action, the Examiner noted that claims 1-34 are pending in the application, that claims 13, 21, and 29 are objected, and that claims 1-34 are rejected. By this amendment, no claims have been cancelled, claims 13, 16, 21, 29 and 30 have been amended, and claims 35-86 have been added as new claims. Thus, claims 1-86 are now pending in the application. The Examiner's rejections are respectfully traversed below.

Claim Objections

Claims 13, 21, and 29 stand objected to because of informalities. Applicant concedes that each claim contains informalities. Applicant has amended the claims to correct the informalities as suggested by the examiner.

Accordingly, Applicant respectfully submits that the claims satisfy the requirements under 35 USC Section 112, second through fifth paragraphs. Withdrawal of this objection is respectfully requested.

Rejection Under 35 USC 112, Second Paragraph

Claims 16 and 30 stand rejected under 35 USC Section 112, second paragraph, as being indefinite. Applicant has amended the claims to further emphasize the claimed invention. With respect to Claim 16, the limitation defined as "candidate/proposition" has been amended to "candidate *or proposition*", as interpreted for examination by the examiner. With respect to Claim 30, the trademark/trade name "InternetTM" has been amended to thoroughly explain the desired attributes of the wide area network being claimed.

Accordingly, Applicant respectfully submits that the claims satisfy the requirements under 35 USC Section 112, second paragraph. Withdrawal of this rejection is respectfully requested.

Antedating The Prior Art Reference of Challenger via Rule 131 Affidavit

Applicant respectfully submits that his application's claim to priority of U.S. Provisional Patent Application SN 60/103,279 entitled DIGITAL ELECTIONS NETWORK SYSTEM WITH ONLINE VOTING AND POLLING, filed on October 6, 1998 enables him to properly antedate the prior art reference of Challenger filed on Dec. 30, 1997 by filing an Affidavit under Rule 131.

Rule 131 provides an applicant with the ability to antedate a reference by establishing facts showing prior invention of the subject matter. The purpose of a 131 affidavit is to overcome the effective date of a reference in support of a rejection. To show prior invention, the applicant must provide facts sufficient to establish one of the following: (1) actual reduction to practice of the invention prior to the effective date of the prior art reference, or (2) conception of the invention prior to the effective date of the reference coupled with diligent completion of the invention of the invention beginning prior to the reference date and culminating subsequent to the reference date (actually or constructively). *See In re Eickmeyer*.

A 131 Affidavit is enclosed as a separate filing with this amendment to show conception of the invention prior to the effective date of the reference coupled with diligent completion of the invention of the invention beginning prior to the reference date and culminating subsequent to the reference date (actually or constructively). The filing of the Rule 131 affidavit does not constitute Applicant's admission that the reference sought to be antedated renders the invention in question

unpatentable and does not create an admission that the invention is unpatentable over the prior art.¹

In the event the Rule 131 affidavit is not considered persuasive or is impermissible the Applicant respectfully submits the following remarks to the claim rejections under 35 USC 102 and 103 found in the Office Action dated September 29, 3003.

Improper Rejections

With respect to claim 11, the examiner states on page 14 that claim 11 is rejected under 103(a) as being unpatentable over Challener et al. as applied to claims 1 and 21. Claim 11 is dependent upon claim 10, which the examiner has not stated as being unpatentable over and this stands as an improper ground for rejection. It is then stated again on page 14 that Challener et al. discloses the method of claim 10, but does not expressly disclose the method of claim 10, composing a poll survey on an individual user station. There is no such claim 10 with that additional element and the proper language would have been claim 11. A response to the anticipated proper grounds is also found below. Withdrawal of this rejection is respectfully requested.

Rejections Under 35 USC 102

Claims 1, 4-7, 10, 12, 14, 15, and 34 stand rejected under 35 USC Section 102(e) as anticipated by *Challener et al.* Section 102(e) requires that the prior art invention to be described in a U.S. Patent invented by another and filed before the date of the applicant's invention. Applicant acknowledges that under 102(e) the prior art invention is described in a single U.S.

¹ *Credle v. Bond*, 25 F.3d 1566, 30 USPQ2d 1911 at 1920-21 (Fed. Cir. 1994).

Patent filed by Challener, a different inventive entity, on Dec. 30, 1997 before the applicants filing date.

Applicant respectfully submits that claims 1, 4-7, 10, 12, 14, 15, and 34 are not anticipated by *Challener et al.* A prima facie case of anticipation is established when the Examiner provides a single reference that teaches or enables each of the claimed elements (as arranged in the claim) expressly or inherently as interpreted by one of ordinary skill in the art. Accordingly an applicant who is able to prove that any one of these five elements is not present will effectively prevent the prima facie case of anticipation from being established.

With respect to claims 1 and 7, Applicant respectfully submits that the subject matter claimed therein patentably distinguishes over Challener et al. This patent is directed toward a computer network based conditional voting system directed toward a method for permitting the voting of a group of individuals base upon the established votes of specific individuals or on the percentage of the overall group that votes in a certain way. In other words, the system permits voters to express and cast votes that are conditional on other events.

Specifically, claim 1 recites "a wide area network to a plurality of individual user stations on the wide area network" and claim 7 recites "transmitting the personal information with the ballot selection over the wide area network to a central server." Challener, et al. does not disclose nor teach the use of a wide area network as examiner alleges at col. 8, lines 7-9 and Fig. 7. Not only is there no mention of a wide area network but Challener, et al. specifically teaches the use of a local area network (also known as a "LAN"), see col. 4, lines 44-54 and Figure 1c.

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, *arranged as in the claim*. *Lindermann Maschinenfabrik GMHB v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984 (emphasis

added). This, the examiner has not done. Thus, Applicant respectfully submits that claim 1 patentably distinguishes over Challener, et al. Withdrawal of this rejection is respectfully requested.

With respect to dependant claims 4-7, and 14-15 which depend directly or indirectly on claim 1 and incorporate all the limitations of claim 1 are therefore are patentably distinguishable over Challener, et al. for the reasons discussed in connection with claim 1. Withdrawal of these rejections is respectfully requested.

With respect to claim 10, Applicant respectfully submits that the subject matter claimed therein patentably distinguishes over Challener et al. Specifically, claim 10 recites "composing a poll survey." Challener, et al. does not disclose nor teach the use of a poll survey as examiner alleges at col. 8, lines 7-9 and Fig. 7. It should be appreciated that there is a difference between a ballot and a poll. While Challener et al. may discuss a ballot system, there appears to be no mention for providing polling over a wide area network by presenting issues to individuals over the network, permitting such individuals to access detailed explanations of the content of the petitions, and permitting such individuals to digitally sign a petition and transit it to a centralized processor where such signatures are verified, compiled and reported to the appropriate governmental agencies as taught by the present invention (see page 5, lines 22-27). Additionally, the present invention utilizes polls not only to collect, tabulate, and report on election votes, but to also gather opinions and provide demographic information. It should be appreciated by one of ordinary skill in the art that there is a difference between balloting and polling. Thus, Applicant respectfully submits that claim 10 patentably distinguishes over Challener, et al. Withdrawal of this rejection is respectfully requested.

With respect to dependant claims 12 and 34 which depend directly or indirectly on claim 10 and incorporate all the limitations of claims 10 are therefore are patentably distinguishable over Challenger, et al. for the reasons discussed in connection with claims 10. Withdrawal of these rejections is respectfully requested.

Rejections Under 35 USC 103

Claims 13 and 21-25 stand rejected under 35 USC Section 103(a) as being obvious in view of *Challener et al.* as applied to claim 6, claims 2, 3, 16, 17, and 19 stand rejected under 35 USC Section 103(a) as being obvious in view of *Challener et al.* as applied to claim 1 and further in view of *Miyagawa et al.*, claims 8, 26, 28-30, 32, and 33 stand rejected under 35 USC Section 103(a) as being obvious in view of *Challener et al.* as applied to claims 1 and 25 and further in view of *McClure et al.*, claims 9, 11, and 27 stand rejected under 35 USC Section 103(a) as being obvious in view of *Challener et al.* as applied to claims 1 and 21 and further in view of *Chisholm*, claim 18 stands rejected under 35 USC Section 103(a) as being obvious in view of *Challener et al.* and *Miyagawa et al.* as applied to claim 17 and further in view of *Chisholm*, claim 19 stands rejected under 35 USC Section 103(a) as being obvious in view of *Challener et al.* and *Miyagawa et al.* as applied to claim 19 and further in view of *McClure et al.*, claim 31 stands rejected under 35 USC Section 103(a) as being obvious in view of *Challener et al.* and *McClure et al.* as applied to claim 28 and further in view of *Chisholm*.

With respect to dependant claims 13 which depends directly or indirectly on claim 6 and incorporate all the limitations of claims 1 and 6 are therefore are patentably distinguishable over Challenger, et al. for the reasons discussed in connection with claims 1 and 6 and, additionally that it contains the additional element of compiling demographic data.

Examiner contends that it is “obvious to one of ordinary skill in the art to compile demographic reports on poll results” and “it is well known in the polling industry to compile results and statistics based on the relationship between poll results and the personal information obtained.” Although the examiner contends that it is well known in the polling industry, not a single piece of prior art, that would be so readily available if well known, has been cited by the examiner. If an examiner does not specifically cite prior art but uses judicial notice or personal knowledge to support an obvious rejection, the level of ordinary skill is not represented by the information the examiner relies upon. From the *Pardo*² decision holds that the examiner must rely upon, at least to some extent, on a reference for describing the level of ordinary skill.

Additionally, factual findings that aspects of an invention are “basic knowledge” or “common sense” to one of ordinary skill in the art do not generally satisfy the substantial evidence standard.

See In re Zurko, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). In the present case the examiner’s assertion that compilations of demographic reports is suggest by Challener, et al., which only teaches capturing or recording such information is insufficient grounds to support an obvious rejection. Withdrawal of these rejections is respectfully requested.

Claim 21 recites similar features as claims 1 and 13, and therefore patentably distinguishes over Challener, et al. for the reasons discussed in connection with claims 1 and 13. Withdrawal of these rejections is respectfully requested.

With respect to claim 22, the Challener et al. patent does not teach the association of each response to a given user. Challener et al. at col. 6, lines 32-35 teaches the process of registering voters and the develop of a smart card (see Fig. 2 and col. 6, lines 32-35) used to allow users with a way to authenticate and cast a vote on a ballot. Challener et al. at col. 10, lines 51-65 actually

² *In re Pardo*, 684 F.2d 912, 214 USPQ 673 (C.C.P.A. 1982).

teaches a means of voting that does not allow the results server to know or the identify of a voter, thus resulting a double blind system that can not allow or enable the association of personal information with a given response. Challener et al. at does not claim a separate method and system for secure computer moderated voting. Thus the patent can only be read to as to utilize a double blind system. Withdrawal of these rejections is respectfully requested.

Claims 23-25 recite similar features as claims 1 and 13, and therefore are patentably distinguishable over Challener, et al. for the reasons discussed in connection with claims 1 and 13. Withdrawal of these rejections is respectfully requested.

Claims 2-3, 16-17, and 19 recite similar features as claims 1 and 10, and therefore are patentably distinguishable over Challener, et al. in view of Miyagawa, et al. for the reasons discussed in connection with claims 1 and 10. Withdrawal of these rejections is respectfully requested.

With respect to claims 8, 26 and 28, the McClure et al. reference does teach the use of any form of biometrics to identify a voter, but does not suggest that doing so enhances or ensures that an eligible and legitimate person is voting and offer not motivation for its specific use. The patent office standard, which is also stated in *Ex Parte Re Qua*, requires that when the incentive to combine teaches of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper and that the examiner must prove more than a general relationship between fields of the prior art patents to be combined is insufficient to establish the suggestion or motivation. The Federal Circuit has stated that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination." See *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). *In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ

206, 208 (C.C.P.A. 1961) held that in concluding that obviousness established by the teachings in various parts of references, the district court lost sight of the principle that there must have been something present in those teachings to suggest to one skilled in the art that the claimed invention before the court would have been obvious. In the present case the examiner cites to no prior art of record a suggestion or motivation that the use of biometrics characteristics enhances security or ensures an eligible and legitimate person is present. Absent any suggestions or motivation found in the prior art, the examiner has no grounds to support this assumption that the use of a biometric characteristic will enhance security, especially when the suggestion comes from the invention or patent being prosecuted itself and is not supported in any other prior art of record. Withdrawal of these rejections is respectfully requested.

Claims 18, 20, 28-30, and 32-33 recite similar features as claims 1, 10, 8, 16, 21, and 26 and therefore are patentably distinguishable over Challener, et al. in view of Miyagawa, et al. for the reasons discussed in connection with claims 1, 10, 8, 16, 21, and 26. Withdrawal of these rejections is respectfully requested.

Claims 9, 11, 27, and 31 recite similar features as claims 1, 10, 16 and 21 and therefore are patentably distinguishable over Challener, et al. in view of Chisholm for the reasons discussed in connection with claims 1, 10, 16 and 21. Withdrawal of these rejections is respectfully requested.

Conclusion

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely.

Respectfully submitted,



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